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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/204,236 12/03/98 HAMILTON

G AR218-X

EXAMINER

HM12/1012

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SIXTH FLOOR
WASHINGTON DC 20005

CHANG, C

ART UNIT

PAPER NUMBER

1625

DATE MAILED:

10/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/204,236

Applicant(s)
Hamilton et al.

Examiner
Celia Chang

Group Art Unit
1625



☒ Responsive to communication(s) filed on May 26, 2000

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 3-8, 11, 14-25, and 72-89 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 3-8, 11, 14-25, and 72-89 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 13

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Amendment and response filed by applicants in paper No. 16, dated July 25, 2000 have been entered and considered carefully. Claims 3-8, 11, 14-25, and newly added claims 72-89 are pending.
2. Initially, applicant's attention is drawn to that claims 26-27 was not included in the previous action but withdrawn. Second, a typographical error was observed in citation of JP 55-153,763 which was cited on 1449 and recited in the rejection on page 3. Subsequent reference to this reference was mis-typed and correction is hereby made. A copy of the JP-55-153763 is hereby attached for applicants' convenience.
3. The rejection of claims 3-8, 11, 14-25 under 35 USC 102(b) or 103(a) in the previous office action is maintained for amended claims 4, 7, 21-24 for reasons of record. Applicants argued that anticipation was not found since the compounds recited in the prior art of rejections were intermediates. Please note that for anticipation of compounds, utility of the prior art compounds do not have to be the same as the claimed use. Prior art compounds are known to be useful for making therapeutical compounds i.e. having utility, anticipation is found.

Further, the prior art compounds such as recited in CA 89:215,152, nitriles which anticipated those compounds when R3 is CN in claim 4, is an intermediate for making penicillates. Nitriles has been known to be "bioisosteres" of the esters which is known in the art to have the same utility as the claims (WO 92/21313). Therefore, a bioisostere of the known esters is expected to have the same utility as the isosteric compound. Therefore, the known nitriles, although used as intermediates in the CA 89 reference, would be expected to have the claimed activity since it is a known bioisostere of the class of nuerotrophic esters. The concept of bioisostere and the equivalency of ester, acid and nitrile are found in the review article by Patani and BIOSIS 05620415 which are attached for applicants convenience.

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4. Claims 5, 8, 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The incorporation of specification by compound number into the claims rendered the claims indefinite. Compounds must be incorporated by name or structure. The express reference to specification in the claim is not permissible. Ex Parte Fressola 27 USPQ2d 1608.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-8, 11, 14-25, and newly added claims 72-89 are rejected under 35 U.S.C. 102(g) or provisionally rejected under 35 USC 102(e) as being anticipated by Bull et al. WO 99/45006 or WO 99/14998.

Claims 3-8, 11, 14-25, and newly added claims 72-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bull et al. WO 99/45006 or WO 99/14998.

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Please note the anticipatory compounds disclosed by WO 99/45006 (supplied by applicants) and WO 99/14998 see pages 198-200.

The generic teaching of Bull et al. WO 99/45006 or WO 99/14998 rendered the broad claims of the instant application obvious.

Please note that the Bull WO-006 or Magal WO-998 qualified as 102(g) reference while its US corresponding application, if allowed (provisional rejection), may qualify as a 102(e) reference. In the event that either Bull or Magal becomes co-owned by the instant assignee, the pending claims constitutes obvious type double patenting.


6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is (703) 308-4702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.
CCC/Chang

Oct. 4, 2000


CEILA CHANG
PRIMARY EXAMINER
PROIP 12001625